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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/386,813	02/08/95	HOGLUND	B 361427-2000

IM71/0412
GEORGE B. SNYDER, ESQ.
WHITMAN BREED ABBOTT & MORGAN LLP
200 PARK AVENUE
NEW YORK NY 10166

EXAMINER

NOLD, C

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 04/12/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/386,813

Applicant(s)
Hoglund

Examiner
Charles R. Nold

Group Art Unit
1772



☒ Responsive to communication(s) filed on 1-21-99, paper no. 18

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 13-28 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 13-28 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1772

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The rejection of claims 14-28 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention set forth in paper no. 13, paragraph no. 3 is withdrawn due to applicants amendments.
2. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "through the lips of die" is clumsy, and indefinite because it lacks antecedent basis for "die". This claim was rejected when the phrase was "the die". The correct claim language would be "through the lips of a die".
3. The rejection of claims 13-28 under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling is withdrawn due to applicant's arguments..

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The rejection of claims 13-28 under 35 U.S.C. 103(a) as being unpatentable over Underwood alone or alternatively in view of Smith as set forth in paper no. 13, paragraph no. 7 is withdrawn in view of the Board of Patent Appeals and Interferences (BPAI) Decision in copending SN 08/730,972 (Decision '972), mailed Nov. 25, 1997 to appellant in copending SN 08/730,972.

In Copending SN 08/730,972 the issues were substantially identical to those in the instant application, thus the boards reversal of the rejection of the copending case would necessarily mean the instant rejection should be removed. A copy of the boards decision is attached to this office action as appendix A. In Decision '972 the BPAI instituted a new ground of rejection. That is also set forth below.

6. Claims 13-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicants' acknowledged prior art in view of Bridgeford US 4,590,107. This rejection is set forth in Decision '972, Appendix A to this paper, page 6, beginning with the third full paragraph to page 11, the beginning of the first full paragraph..

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R. Nold whose telephone number is (703) 308-4416.



CHARLES NOLD
PRIMARY EXAMINER
GROUP 1300
Tech 1700

08/386,813

Appendix A

Paper no. 20
4/13/99

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

NOV 25 1997

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BORIS HOGLUND, EDMUND KING AND
VIDAR KALM

Appeal No. 95-4026
Application 07/730,972¹

HEARD: November 12, 1997

Before COHEN, MEISTER and FRANKFORT, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 6 through 12. These claims constitute all of the claims remaining in the application.

Appellants' disclosed invention pertains to a method for

¹ Application for patent filed July 26, 1991.

Noted
Ever
3/5/98

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manufacturing a sausage-packaging tubing and to a tubing used for the packaging of sausages. A basic understanding of the invention can be derived from a reading of exemplary claims 6 and 10 copies of which appear below.

6. A method for manufacturing a sausage-packaging tubing which method comprises:

forming a paper base material into a tube, which base material comprises long-fibered manilla hemp paper which paper is wet strengthened by viscose, said paper having an air-dry weight of no more than 15g/m^2 ;

impregnating the paper tube with viscose and then treating it with one or more acid and salt baths, so as to coagulate the viscose, thereby regenerating the viscose into cellulose in such a manner that the paper fibers are embedded and bonded with the regenerated cellulose.

10. A tubing used for the packaging of sausages, which tubing comprises a paper base material of long-fibered manilla hemp paper, having an air-dry weight of no more than 15 g/m^2 , and which hemp paper is impregnated with viscose and then treated with one or more acid and salt baths so as to coagulate the viscose, thereby regenerating the viscose into cellulose in such a manner that the paper fibers are embedded and bonded with the regenerated cellulose and which is then plasticized using glycerol.

As evidence of obviousness, the examiner has applied the following:

Appellants' admission of prior art (Paper No. 8, paragraph No. 17)

Smith

2,105,273

Jan. 11, 1938

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Underwood

3,433,663

Mar. 18, 1969

Additional prior art teachings relied upon by this panel of the board are:

Appellants' acknowledgment of conventional "Heavy fibre material tubing" (specification, page 5 and TABLE on page 6)

Bridgeford ²

4,590,107

May 20, 1986

The following rejections are before us for review.

Claims 6 through 9 stand rejected under 35 USC § 103 as being unpatentable over appellants' admission of prior art (specification, page 1, line 31 to page 2, line 7 and page 3, lines 20 through 27).

Claims 6 through 12 stand rejected under 35 USC § 103 as being unpatentable over Underwood alone, or alternatively, in view of Smith.

The full text of the examiner's rejections and response to the argument presented by appellants appear in paragraphs 17 and 18 of the office action dated March 18, 1993 (Paper No. 8) and the answer (Paper No. 16), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 15 and 17).

² This patent is of record in the application.

OPINION

In reaching our conclusion on the obviousness issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims, the applied teachings,³ and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The rejection of claims 6 through 9

We do not sustain the rejection of claims 6 through 9 under 35 USC § 103.

The examiner concludes that the claimed process is unpatentable since it only differs from what would have been suggested by the prior art by incorporating a different starting material. However, to support a rejection of appellants' process claims under 35 USC § 103, the collective teachings must have suggested that the claimed invention would have been obvious.

³ In our evaluation of the applied teachings, we have considered all of the disclosure of each teaching for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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Interpretating a claimed process as a whole, requires a consideration of all claim limitations. The language in a process claim pertaining to the starting material is a material limitation and a motivation to use the particular starting material must be present in the prior art for a rejection under 35 USC 103 to be sustained. See In re Ochiai, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1131 (Fed. Cir. 1995) and In re Brouwer, 77 F.3d 422, 426, 37 USPQ2d 1663, 1666 (Fed Cir. 1996). In the present case, as evidently appreciated by the examiner, the prior art teachings relied upon would not have been suggestive of using the specifically claimed hemp paper having an air-dry weight of "no more than 15g/m²". Thus, the rejection of claims 6 through 9 under 35 USC § 103 cannot be sustained.

The rejection of claims 6 through 12

We do not sustain the rejection of claims 6 through 12 under 35 USC § 103. Simply stated, it is our determination that the evidence relied upon by the examiner would not have been suggestive of the claimed method and tubing. The Underwood patent alone would not have rendered the claimed invention obvious since it lacks a suggestion for the specifically claimed hemp paper having an air-dry weight of "no more than 15g/m²". As to the combined teachings of Underwood and Smith, we readily

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perceive that a suggestion therefrom for the use of hemp paper having an air-dry weight of "no more than 15g/m²" is also lacking. Thus, the rejection of appellants' claims based upon Underwood alone and in view of Smith cannot be sustained.

New ground of rejection

Under the authority of 37 CFR 1.196(b), this panel of the board introduces the following new ground of rejection.

Claims 6 through 12 are rejected under 35 USC § 103 as being unpatentable over appellants' acknowledged prior art in view of Bridgeford.

We are informed by appellants (specification, pages 1 through 3) as to the known or conventional collagen casings and fibre-reinforced cellulose casings used for encasing food products such as in the manufacture of sausages. The process of manufacturing paper used in the latter casings, such as manilla hemp based paper, is indicated by appellants to be described in U.S. Patent Nos. 3,433,663 and 3,135,613. Methods and devices for manufacturing hose like tubings are disclosed by appellants as being taught by U.S. Patent Nos. 2,144,899 and 2,105,273. Appellants also address "conventional tubing composed of heavier fibrous material" (specification, page 5) and specify weights of 17 g/m², 19 g/m², 21 g/m², and 23 g/m² for the "Heavy fibre

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material tubing" of the "TABLE" on page 6 of the specification. As to the Bridgeford patent (column 4, lines 55 through 58 and claim 2), this document reveals to us that those having ordinary skill in the art had an economic incentive to reduce basis weight in sausage casings and that it was known to use a basis weight of cellulose in the range of "about 15 to about 25 grams/square meter of cellulose" (claim 2) for an casing of regenerated cellulose.

The perceived difference between appellants' acknowledged prior art method and tubing is the claimed recitation of long-fibered manilla hemp paper having an air-dry weight of no more than 15g/m².

The TABLE in the present specification makes it clear to us that those having ordinary skill in the art were motivated not only to use heavier paper of 23g/m² but also to progressively use lighter papers (21 and 19 g/m²) down to a paper weight of 17g/m². As discussed above, the Bridgeford patent additionally evidences the incentive on the part of those practicing the art to seek lighter tubings, and claim 2, in particular, explicitly reveals a cellulose range of about 15 to about 25 grams/square meter.

In applying the test for obviousness,⁴ we reach the conclusion that it would have been obvious to one having ordinary skill in the art, from a combined consideration of the applied teachings, to effect appellants' claimed method and tubing. From our perspective, those having ordinary skill in the art would have clearly had an economic incentive to effect a method and tubing relying upon the lightest hemp paper capable of forming a satisfactory sausage packing. More specifically, it is readily apparent to us that the acknowledged prior art (TABLE) and Bridgeford teaching would have been suggestive of relatively light weight casings, for example, 17g/m² and "about 15 grams/square meter." In this instance, paper weight is fairly viewed as a result effective variable. The selection of an appropriate light weight is seen to be simply the discovery of an optimum value of a result effective variable. See In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). For these reasons, we conclude that the claimed method and tubing requiring

⁴ The test for obviousness is what the combined teachings of references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

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"no more than 15g/m²" of hemp paper would have been obvious to one having ordinary skill in the art. Based upon the above, we reject claims 6, 7, 8, and 10 through 12. As to the subject matter of claim 9, a diameter less than about 165 mm would have been suggested by conventional diameters of 35mm through 105mm (Table 6 in the specification). Accordingly, a *prima facie* case of obviousness has been established.

At this point, we turn our attention to appellants' view that sufficient evidence exists to rebut a *prima facie* case of obviousness (main brief, page 14 through 18 and reply brief, pages 4 through 7).

It is noted that the comparative showing in the specification (TABLE on page 6) only addresses a paper weight of precisely "13" g/m² with respect to appellants' invention. This showing concerning precisely "13 g/m²" is of remote relevance since it does not address the claimed range recitations of "no more than 15g/m²" (claims 6 and 10), "no more than 13 g/m²" (claim 7 and 11), and "12 to 14 g/m²" (claim 8 and 12). As to the Exhibits appended to the brief, they clearly are not in affidavit or declaration form and, thus, can only be viewed as attorney arguments with respect to the matters addressed therein. Since appellants' showing relative to a paper weight of 13 g/m²

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(Table on page 6 of the specification) and arguments (main brief, pages 14 through 18) do not pertain to the specifically claimed paper weight range, the assertions as to surprisingly and unpredictably smoother casings, increased casing burst strength, and improved results for the claimed invention are simply unsupported by competent evidence. Thus, what appellants have referred to in the main brief (page 14) as data of record establishing non-obviousness (Table in specification and Exhibits) is of remote relevance to the claimed subject matter. Clearly, appellants have not satisfied the burden of proving that the claimed process and tubing produced unexpected results in the "claimed" weight range. See In re Geisler, 116 F.3d 1465, 1470, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

With respect to the argued "commercial success of casings which are the subject of this invention" (main brief, page 15), the sparse information given is inadequate and can be accorded only very minimal weight. For commercial success of a product embodying a claimed invention to have true relevance to the issue on nonobviousness, the success must be shown to have in some way been due to the nature of the claimed invention, as opposed to other economic and commercial factors. This has been referred to as the nexus that is required between the merits of the claimed

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invention and the evidence offered, if the evidence is to be given substantial weight en route to a conclusion on an obviousness issue. See Cable Electric Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 1026, 226 USPQ 881, 888 (Fed. Cir. 1985). More than a mere showing that there was commercial success and that the commercially successful article embodied the invention is required. See, for example, In re Heldt, 433 F.2d 808, 812, 167 USPQ 676, 679 (CCPA 1970) and In re Noznick, 478 F.2d 1260, 1263, 178 USPQ 43, 44 (CCPA 1973). What is required is a showing that the commercial success was due to the merits of the claimed invention, i.e. that the claimed features were responsible for the commercial success, if the evidence of nonobviousness is to be accorded substantial weight. See Ex parte Remark, 15 USPQ 1498 (BPAI 1990). In the present case, the minimal weight attributed to appellants' showing does not outweigh the weight accorded the evidence of obviousness.

In summary, this panel of the board has:

reversed the rejection of claims 6 through 9 under 35 USC § 103 as being unpatentable over appellants' admission of prior art (specification, page 1, line 31 to page 2, line 7 and page 3, lines 20 through 27); and

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reversed the rejection of claims 6 through 12 under 35 USC § 103 as being unpatentable over Underwood alone, or alternatively, in view of Smith.

Additionally, we have introduced a new ground of rejection of claims 6 through 12 pursuant to our authority under 37 CFR 1.196(b). The decision of the examiner is reversed.




Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision (37 CFR 1.197). Should appellants elect to have further prosecution before the examiner in response to the new rejection under 37 CFR 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

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37 CFR 1.136(a) does not apply to the times for taking any subsequent action in connection with this appeal.

REVERSED

37 CFR 1.196(b)

)	
IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
JAMES M. MEISTER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

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Fred A. Keire
Curtis, Morris & Safford
530 5th Avenue
New York, NY 10036